Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIHIRO GOTO and TOSHIO MORO

Appeal No. 2003-1943
Application No. 09/937,220

ON BRIEF

Before PAK, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative Patent Judges.

PAK, Administrative Patent Judge.

REMAND

On this record, we determine that this case is not ripe for meaningful review and is, therefore, remanded to the examiner for appropriate action not inconsistent with the views expressed below.

The examiner rejected claims 1 through 3 under 35 U.S.C. § 102(b) as anticipated by the disclosure of U.S. Patent 5,434,380 issued to Magara et al. on July 18, 1995 (hereinafter referred to

as "Magara"). See the Answer, page 3. This rejection, however, did not take into consideration the means-plus-function limitation recited in apparatus claim 1. Specifically, the rejection did not refer to any specification structure which is said to be corresponding to "a control means for dividing an electric discharge current pulse..." recited in apparatus claim 1. *In reDonaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(*in banc*)(When the term in a claim is written in a "means-plus-function" format, it must be interpreted as being limited to the corresponding structure described in the specification and equivalents thereof in accordance with the requirements of 35 U.S.C. § 112, paragraph 6). Thus, both the examiner and the appellants failed to fully address the applicability of Magara to the properly construed apparatus claim in question.

As stated in *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997),

> structure disclosed in the specification is "corresponding" structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, ¶ 6.

Moreover, according to *Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999),

the particularity requirement of 35 U.S.C. §112, second paragraph, cannot be satisfied unless

> the corresponding structure(s) of a means-plus-function limitation . . . [is] **disclosed** in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation. Otherwise, **one does not know what the claim means**. Emphasis added.

The structures equivalent to the corresponding structure described in the specification include those which

1) perform substantially the same function in substantially the same way to produce substantially the same result, *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1990);

2) have insubstantial differences, *Valmount Indus. Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042-44, 25 USPQ2d 1451, 1453-56 (Fed. Cir. 1993);

3) are structurally equivalent, *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990); and

4) a person having ordinary skill in the art would have recognized as interchangeable, *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999).

Thus, upon return of this application, the examiner is advised to determine whether the structure corresponding to the claimed

control means is adequately described in the specification within the meaning of 35 U.S.C. § 112, second paragraph. If the corresponding structure is adequately described in the specification, the examiner is advised to determine whether Magara or any other prior art references individually or in combination teaches or would have suggested such corresponding structure or equivalents thereof. Any rejection resulting from the above claim interpretation requires reopening of the prosecution of this application.

This application, by virtue of its "special" status requires immediate action. *See Manual of Patent Examining Procedure (MPEP)* 708.01 (8th Ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this application.

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REMANDED

CHUNG K. PAK)
Administrative Patent Judge)
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JEFFREY T. SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

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